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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/764,029 | 01/22/2004 | Carl Cetera | SS-108 | 7946 |
| 35693 | 7590 | 10/26/2005 | EXAMINER | |
| THE SONI LAW FIRM 55 S. LAKE AVE SUITE 720 PASADENA, CA 91101 | | | WALCZAK, DAVID J | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3751 | |

DATE MAILED: 10/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/764,029 | CETERA, CARL | |
| | Examiner | Art Unit | |
| | David J. Walczak | 3751 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10, 13 and 14 is/are pending in the application.
- 4a) Of the above claim(s) 13 and 14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>1/22/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election

Applicant's election without traverse of Group I in the reply filed on 9/1/05 is acknowledged. It is noted that new method claims 13 and 14 will not be examined herein as they are not directed to the elected group (the apparatus defined in claims 1-10). New claims 13 and 14 are separable from claims 1-10 in that the apparatus as claimed can be used to practice another and materially different process, such as a process of entertaining a child, as opposed to advertising, or a process wherein the indicia is printed on the slidable member, as opposed to on the outer surface of the clip or the outer surface of the instrument. Accordingly, claims 1-10 will be examined herein.

Abstract

The abstract of the disclosure is objected to because phrases which can be implied, such as "is disclosed" and "Also disclosed" should not be present therein. Correction is required. See MPEP § 608.01(b).

Specification

The disclosure is objected to because of the following informalities: There is no "brief description" of Figure 6 present in the appropriate section on page 4. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Hsieh.

Hsieh discloses a writing instrument 20, a clip attached at an upper and thereof to the writing instrument and comprised of two parallel metal wire rails 12 (see the last line of column 2) wherein the rails are connected at the lower end of the clip and a slidable member 30 having indicia thereon slidingly articulated on the rails (during assembly, the member 30 is slid onto the rails).

Claims 1-3, 5, 6, 8 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Harris. In regard to claims 1-3 and 5, Harris discloses a writing instrument 10, a clip attached at an upper and thereof to the writing instrument and comprised of two parallel rails 15 wherein the rails are connected at the lower end of the clip and a slidable member 18 having indicia thereon slidingly articulated on the rails (see column 2, lines 20-27). In regard to claim 6, the slidable member includes an inner segment 19, a middle segment (not shown) and an outer segment 18 which are structured as claimed. In regard to claims 8 and 9, an “advertising logo” is present on the outer surface of the outer segment (see Figure 1).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Harris in view of Deutsch. Although the indicia is not covered with a transparent portion, attention is directed to the Deutsch reference, which discloses that indicia is commonly covered with such a transparent portion in order to protect the indicia (see column 4, lines 15-20). Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include such a transparent element (which would become the "outer segment") over the indicia in the Harris device in order to protect the indicia.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Harris in view of Bizzarri. Although the Harris reference does not disclose that the indicia is "imprinted with three dimensional textures" (i.e., raised), attention is directed to the Bizzarri reference, which discloses that indicia is commonly raised in order to improve the aesthetics of the device (see column 3, lines 3-10). Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to form the indicia present on the Harris device as raised indicia in order to improve the aesthetics of the device.

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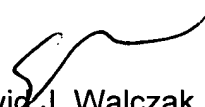
Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The Petroskey et al., Higgins and Beck references are cited for disclosing other clip structures.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David J. Walczak whose telephone number is 571-272-4895. The examiner can normally be reached on Mon-Thurs, 6:30- 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Justine Yu can be reached on 571-272-4835. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



David J. Walczak
Primary Examiner
Art Unit 3751

DJW
10/25/05